

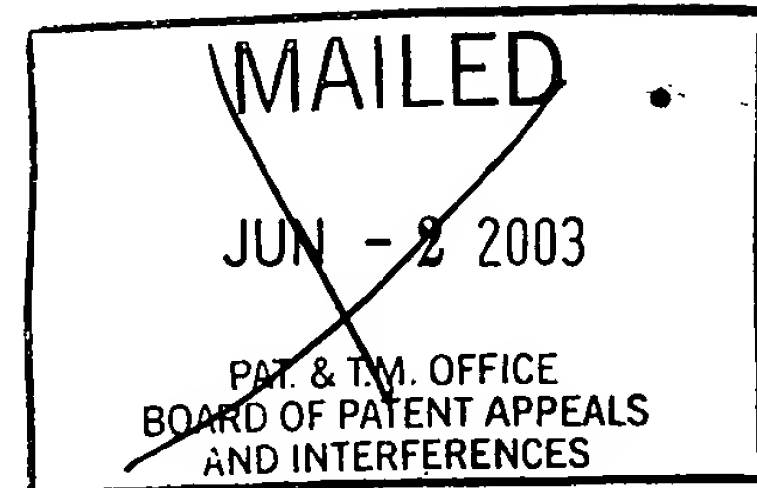
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERARD LANG, JEAN COTTERET,
and MIREILLE MAUBRU



Remailed 6-19-03

Appeal No. 2003-0465
Application No. 09/424,119

HEARD: May 20, 2003

Before GARRIS, PAK, and DELMENDO Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 18-42 which are all of the claims remaining in the application.

The subject matter on appeal relates to a composition, as well as to a kit, for the oxidation dyeing of keratin fibers comprising at least one heterocyclic oxidation base and at least

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one 3-aminopyridine derivative as a direct dye chosen from compounds having a particular formula. This appealed subject matter is adequately illustrated by independent claim 18, a copy of which taken from the appellants' brief is appended to this decision.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Lang	4,025,301	May 24, 1977
Clausen et al. (Clausen)	5,061,289	Oct. 29, 1991

All of the claims on appeal stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of Clausen.¹ On page 4 of the answer, the examiner expresses his obviousness conclusion as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to at least partially substitute the p-aminophenol oxidation bases in the compositions and processes of Lang (which use direct dyes of formula (1) as claimed), resulting in dyeing compositions and processes as claimed, because Lang does not require any specific oxidation dyes for use in the patentee's compositions, and Clausen teaches that the claimed diaminopyrazoles

¹ Notwithstanding the contrary indication on page 5 of the brief, the appealed claims will stand or fall together for the reasons explained by the examiner on page 2 of the answer which reasons have not been contested by the appellants in their brief filed November 25, 2002 in reply to the answer. Accordingly, in assessing the merits of the rejection before us, we will focus on independent claim 18 as representative of the here rejected claims. See 37 CFR § 1.192(c)(7)(8)(2001).

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have various improvements over conventionally used p-aminophenols such as improved physiological properties and the ability to obtain brilliant red shades with a great depth of color. Clausen also teaches that the diaminopyrazoles are compatible with conventional direct dyes, further motivating those skilled in the art to add such dyes to Lang's compositions.

Rather than reiterate the respective positions advocated by the appellants and by the examiner concerning the above noted rejection, we refer to the brief and reply brief and to the answer for a complete exposition thereof.

OPINION

We will sustain this rejection for the reasons well stated in the answer and for the reasons set forth below.

Notwithstanding a complete consideration of the arguments and evidence advanced by the appellants in their brief and reply brief, we are convinced that the reference evidence adduced by the examiner establishes a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. That is, a prima facie case exists for concluding that it would have been obvious for one with ordinary skill in the art to combine the compositions of Lang and Clausen in the manner and for the reasons thoroughly discussed by the examiner in order to form a composition corresponding to that defined by appealed independent claim 18. As explained by the predecessor of our reviewing court, it is

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prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, as here, in order to form a third composition which is to be used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The idea of combining them flows logically from their having been individually taught in the prior art. Id.

It is the appellants' position that the applied prior art would not have motivated an artisan to combine Lang and Clausen in the manner proposed by the examiner whereby the para-aminophenol oxidation base of Lang's compositions (e.g., the composition of Example q in column 22) is at least partially replaced with a diaminopyrazole oxidation base taught by Clausen. We agree with the examiner, however, that Clausen teaches a number of advantages with respect to his diaminopyrazole oxidation bases, any single one of which would have motivated an artisan to effect the proposed replacement. These advantages range from avoiding the possibility of para-aminophenol (i.e., 4-aminophenol) not being physiologically tolerated (e.g., see lines 43-46 in column 1 of Clausen)² to obtaining the hair coloring

² According to argument advanced in the reply brief, "Clausen's passing statement about the physiologically tolerability of 4-aminophenol is not supported by any data or

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benefits of Clausen's diaminopyrazole oxidation bases (e.g., see lines 50-68 in column 4 and lines 1-10 in column 5).

It is also the appellants' position that the applied references would not have provided the artisan with a reasonable expectation that the examiner's proposed combination would have been successful. In support of this position, the appellants emphasize the unpredictability which attends this art. Like the examiner, we recognize this unpredictability but, unlike the appellants, do not consider it incompatible with a reasonable expectation of success. Indeed, if persuasive, the appellants' position on this matter would necessarily raise the issue of whether the broadly defined composition of appealed independent

other evidence from which one skilled in the art could conclude the existence or degree of the alleged problem" (reply brief, pages 7-8), and, therefore, "[a]bsent such data or evidence, Applicants submit that there is insufficient motivation for one skilled in the art to rely on Clausen's passing statement" (reply brief, page 8). This argument lacks discernible merit. On the record before us, no basis exists for doubting the aforementioned disclosure of Clausen who may be properly regarded as a person having knowledge and skill in this art. On the other hand, the validity of the argument under consideration is questionable simply because the attorney who made it can not be properly regarded as a person of knowledge and skill in this art. Compare In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) (mere lawyer's arguments unsupported by factual evidence are insufficient to establish unexpected results).

claim 18 is enabled by the relatively narrow range of compositions exemplified in their specification disclosure.³

With further regard to the issues of motivation and reasonable expectation of success, the appellants concede that Clausen expressly teaches in the paragraph bridging columns 2 and 3 the use of his diaminopyrazole oxidation bases in combination with conventional direct-dyeing dyestuffs but argue that the specific examples of such dyestuffs listed in this paragraph define a class of direct dyes which does not include the direct dyes of Lang. This argument is not well taken. It is significant that the specific dyes listed in this paragraph are characterized by Clausen as examples of conventional direct-dyeing dyestuffs for use in combination with his diaminopyrazole oxidation bases. This fact would have suggested to an artisan that the types of dyes specifically listed in Clausen's paragraph are merely exemplary, rather than exhaustive as the appellants would have us believe, of the dye types which may be used in

³ ~~It is here appropriate to stress that we see no basis for considering the unpredictable nature of this art to support a determination that an artisan would not be able to practice the here claimed invention just as we see no basis for considering the unpredictable nature of this art to support a determination that an artisan would have no reasonable expectation of success concerning the examiner's proposed combination of Lang and Clausen.~~

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combination with the diaminopyrazole oxidation bases. For this reason, we share the examiner's position that the artisan would have considered patentee's disclosure of conventional direct-dyeing dyestuffs as suggesting direct dyes which are conventionally used in combination with oxidation bases such as the direct dyes of Lang.

As indicated earlier, we have fully considered the arguments and evidence advanced in the brief and reply brief including, for example, such arguments as the appellants' contention that the applied references actually teach away from the combination proposed by the examiner and their contention that the examiner's proposed combination is the result of improper picking and choosing certain reference teachings while ignoring others. We discern no convincing merit in such argument or evidence for the reasons adequately expressed in the answer.

Under the circumstances set forth above and in the answer, it is our determination that the applied references evince a prima facie case of obviousness which the appellants have not successfully rebutted with argument or evidence of
nonobviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). It follows that we will sustain the

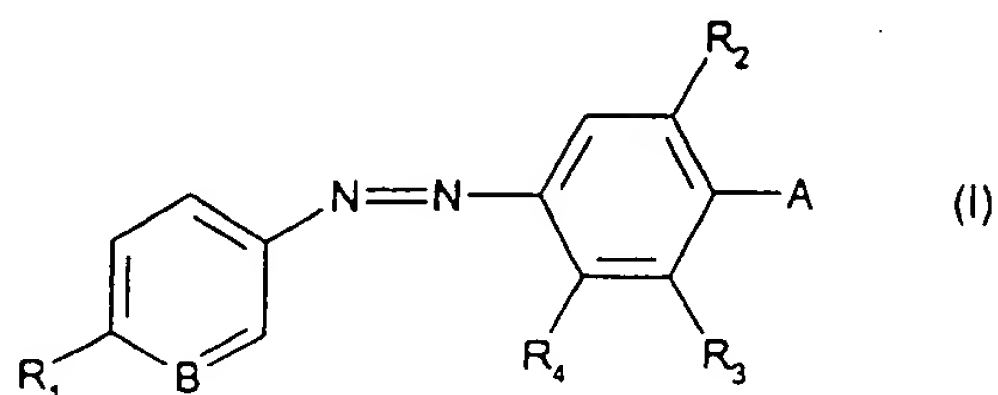
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APPENDIX

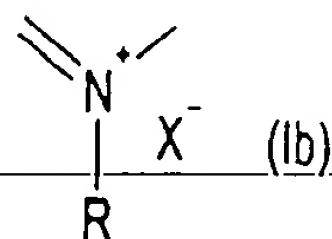
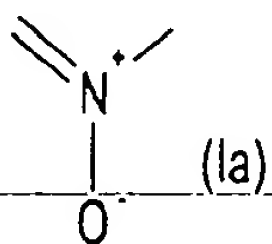
18. A composition for the oxidation dyeing of keratin fibers, comprising:

- a) at least one heterocyclic oxidation base, and
- b) as a direct dye, at least one 3-aminopyridine derivative chosen from the compounds of formula (1):



in which:

- B is chosen from formula (1a) or (1b):



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- R is a C₁-C₄ alkyl radical;
- R₁ is chosen from a hydrogen atom, a halogen atom, a C₁-C₄ alkyl radical, and a C₁-C₄ alkoxy radical;
- R₂ is chosen from a hydrogen atom, a C₁-C₄ alkyl radical and a C₁-C₄ alkoxy radical;
- R₄ is chosen from a hydrogen atom, a halogen atom, a C₁-C₄ alkyl radical, a nitro radical, an amino radical and a (C₁-C₄)acylamino radical;
- R₃ is a hydrogen atom, or R₄ and R₃ together form a 6-membered unsaturated ring bearing a hydroxyl substituent chelated with one of the nitrogen atoms of the azo double bond;
- A is a residue -NR₅R₆ in which R₅ is chosen from a hydrogen atom, a C₁-C₄ alkyl radical, a C₁-C₄ monohydroxyalkyl radical and a C₂-C₄ polyhydroxyalkyl radical; and R₆ is chosen from a hydrogen atom, a C₁-C₄ alkyl radical, a C₁-C₄ monohydroxyalkyl radical, a C₂-C₄ polyhydroxyalkyl radical, a phenyl ring and a -CH₂-SO₃Na radical; and
- X is chosen from a monovalent anion and a divalent anion.